

## **REMARKS**

Applicants have received the Final Office Action dated December 10, 2007, in which the Examiner: 1) lodged a provisional double patenting rejection of claims 1, 17 and 23 over claim 12 of co-pending application Serial No. 10/684,207; 2) rejected claims 1-10, 12-19 and 21-25 as allegedly obvious over Carlson et al. (U.S. Publication No. 20040044862, hereinafter Carlson) in view of Kanai et al. (U.S. Publication No. 20020152181, hereinafter Kanai).

With this Preliminary Amended, Applicants amend claims 1, 3-10, 12-19 and 21-25, and cancel claim 2.

### **I. DOUBLE PATENTING REJECTION**

Given the provisional nature of the double patenting rejection, Applicants respectfully decline to take any action until such time as rejection is non-provisional.

### **II. CLAIM AMENDMENTS**

With this Preliminary Amendment, Applicants present a plurality of amendments to the claims to put the claims in better condition for appeal, and not to define over any cited art.

With respect to claim 1, Applicants, remove the "one or more" language as "a future execution" does not preclude multiple future executions, and remove the "scratch" terminology. Further, Applicants correct antecedent basis shortcomings caused by inconsistent use of the terms "required number" and "number of required" in reference to media with use of the terms "projected number of media." Similar amendments are made to claims that depend from claim 1.

Applicants further amend claims 3, 5 and 12-13 to put the claims in more proper dependent method form.

With respect to claim 17, Applicants the "one or more" language as above, remove the "scratch" terminology, and add the term "configured" to ensure that the wording that follows "to" cannot be ignored as optional or directed to intended use. Further, Applicants correct antecedent basis shortcomings in dependent claims caused by inconsistent use of the terms "required number" and "number of

required” in reference to media with use of the terms “number of media.” Similar amendments are made to claims 18-19 and 21-22.

With respect to claims 23-25, Applicants amend the claims to remove the “method-like” terminology to ensure the claims are treated as structural (machine-readable media) claims, and not merely method claims. Moreover, Applicants remove the “required” and “needed” language as discussed above, and remove the “scratch” terminology.

### **III. ART-BASED REJECTIONS**

#### **A. Claim 1**

Claim 1 stands rejected as allegedly obvious over Carlson and Kanai. Applicants amend claim 1 as discussed above, and also amend claim 1 to more clearly define over Carlson and Kanai which appear to deal solely in historical information.

Carlson is directed to a method, system, and program from managing storage units in storage pools. (Carlson Title). Although software may perform the physical work of moving tapes from pool to pool, the actual selection appears to rest solely in a system administrator.

FIG. 7 illustrates a GUI panel 300 for a system administrator to use when selecting a list or range of physical volumes to move 302 and 304 to a target pool 308... .

(Carlson Paragraph [0057]).

Upon receiving (at block 350) a request to move a list of physical volumes that are not empty, which may be received through the GUI panel 300 (FIG. 7)... .

(Carlson Paragraph [0058]).

FIG. 9 illustrates a GUI panel 400 in which the administrator may enter a number of physical volumes 402 to move, the source pool 404 from which to move the physical volumes, the target pool 406 to which the selected number of physical volumes will be moved... .

(Carlson Paragraph [0059]).

Kanai is directed to a service method of rental storage and a rental storage system. (Kanai Title). Kanai is concerned with online rental storage space, and

updating a customer's contract as storage space grows. (*See, e.g.*, Abstract). Even if some of the storage space rented from Kanai is on a tape drive, Kanai does not concern the user with the number of media; rather, Kanai appears to deal in absolute storage space. (*See, e.g.*, Figure 17 (showing a rising space usage, and a contracted amount of storage space, but no reference to media used for the storage)).

Claim 1, by contrast, specifically recites, "obtaining information regarding a future backup from one or more backup applications for a plurality of backup jobs; calculating a projected number of media for a future execution of at least one of the backup jobs using the information regarding the future backup, said calculating also comprising dividing an average historical backup size of the backup job by an average capacity of a media type associated with the backup job." Applicants respectfully submit that Carlson and Kanai fail to teach or suggest such a system. In particular, in Carlson it appears that the Administrator performs the pool selection work. Thus, even if hypothetically the teachings of Kanai are precisely as the Office action suggests (which Applicants do not admit), Carlson and Kanai still fail to teach or suggest "calculating a projected number of media for a future execution of at least one of the backup jobs using the backup job information...; and presenting the projected number of media to a user." For this reason alone the rejection should be withdrawn.

Moreover, Kanai deals in absolute storage space in relation to a contract, based on historical usage. Thus, the concern of Kanai is not how many media to use, but how much storage space might be used based on historical usage and updating the contract accordingly. Thus, Carlson and Kanai fail to teach or suggest "obtaining information regarding a future backup from one or more backup applications for a plurality of backup jobs" and "dividing an average historical backup size of the backup job by an average capacity of a media type associated with the backup job."

Based on the foregoing, Applicants respectfully submit that claim 1, and all claims which depend from claim 1 (claims 2-10 and 12-16), should be allowed.

**B. Claim 17**

Claim 17 stands rejected as allegedly obvious over Carlson and Kanai. Applicants amend claim 17 as discussed above, and not to define over any cited art.

Claim 17 recites, “a planner configured to calculate a number of media for a future execution of at least one of the backup jobs using the backup job information, the number of media for the future execution calculated by said planner by dividing the average historical backup size of the backup job by an average capacity of a media type associated with the backup job.” Applicants respectfully submit that Carlson and Kanai fail to teach or suggest such a system. In particular, in Carlson it appears that the Administrator performs the pool selection work. Thus, even if hypothetically the teachings of Kanai are precisely as the Office action suggests (which Applicants do not admit), Carlson and Kanai still fail to teach or suggest a system with “a planner configured to calculate a number of media for a future execution of at least one of the backup jobs using the backup job information.” For this reason alone the rejection should be withdrawn.

Moreover, Kanai deals in absolute storage space in relation to a contract. Thus, the concern of Kanai is not how many media to use, but how much storage space will be used in relation to previous contractual relationships. Thus, Carlson and Kanai fail to teach or suggest “the number of media for the future execution calculated by said planner by dividing the average historical backup size of the backup job by an average capacity of a media type associated with the backup job.”

Based on the foregoing, Applicants respectfully submit that claim 17, and all claims which depend from claim 17 (claims 18-19 and 21-22), should be allowed.

**C. Claim 23**

Claim 23 stands rejected as allegedly obvious over Carlson and Kanai. Applicants amend claim 23 as discussed above, and not to define over any cited art.

The Office action fails to make a *prima facie* case of obviousness. Claim 23 is directed to a machine-readable medium, yet the rejections presented by the Office action appear to be based on construing claim 23 as a method claim. For this reason alone the rejection should be withdrawn.

Moreover, Carlson fails to teach, and in fact teaches away from, an automated system as in Carlson it appears the Administrator makes decisions regarding media and media pools and provides the information to the program via the user interfaces. While Kanai shows a tape drive, Kanai does not appear to discuss operations in relation to multiple media for the tape drive. Thus, Carlson and Kanai fail to teach or suggest a machine-readable medium having instructions to perform functions performed by the Administrator in Carlson, and not even discussed in Kanai.

Based on the foregoing, Applicants respectfully submit that claim 23, and all claims which depend from claim 23 (claims 24-25), should be allowed.

#### **IV. CLAIM CANCELLATION**

With this Preliminary Amendment, Applicants cancel claim 2 without prejudice to later asserting the claim, such as in a continuation.

#### **V. CONCLUSION**

In the course of the foregoing discussions, Applicants may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. Moreover, it should be understood that there may be other distinctions between the claims and the cited art which have yet to be raised, but which may be raised in the future.

Applicants respectfully request reconsideration and that a timely Notice of Allowance be issued in this case. It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are

**Appl. No. 10/684,001**

**Prelim. Amdt. dated January 18, 2008**

**Reply to Final Office Action of December 10, 2007**

hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to Hewlett-Packard Development Company's Deposit Account No. 08-2025.

Respectfully submitted,

/Mark E. Scott/

Mark E. Scott

PTO Reg. No. 43,100

CONLEY ROSE, P.C.

(512) 610-3410 (Phone)

(512) 610-3456 (Fax)

ATTORNEY FOR APPLICANTS

HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
Legal Dept., M/S 35  
P.O. Box 272400  
Fort Collins, CO 80527-2400